

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

TEAM WORLDWIDE CORPORATION, Plaintiff, v. ACADEMY, LTD d/b/a ACADEMY SPORTS + OUTDOORS, Defendant.	Case No. 2:19-cv-92-JRG-RSP LEAD CASE
ACE HARDWARE CORPORATION,	Case No. 2:19-cv-00093-JRG-RSP
AMAZON.COM, INC, AMAZON.COM LLC,	Case No. 2:19-cv-00094-JRG-RSP
BED BATH & BEYOND INC.,	Case No. 2:19-cv-00095-JRG-RSP
COSTCO WHOLESALE CORPORATION,	Case No. 2:19-cv-00096-JRG-RSP
DICK'S SPORTING GOODS, INC.,	Case No. 2:19-cv-00097-JRG-RSP
THE HOME DEPOT, INC.,	Case No. 2:19-cv-00098-JRG-RSP
MACY'S, INC., MACY'S.COM, LLC,	Case No. 2:19-cv-00099-JRG-RSP
TARGET CORPORATION, and TARGET BRANDS, INC.,	Case No. 2:19-cv-00100-JRG-RSP
SEARS, ROEBUCK AND CO., SEARS HOLDINGS CORPORATION, and TRANSFORM HOLDCO LLC,	Case No. 2:20-cv-00006-JRG-RSP
Defendants.	CONSOLIDATED CASES

DEFENDANTS' OBJECTIONS TO ORDER ON MOTIONS *IN LIMINE*

Pursuant to Federal Rule 72 and Local Rule CV-72(b), Defendants hereby object to the Magistrate Judge's Order on Motions *in Limine*. (ECF No. 394 ("Order").) Specifically, Defendants object to the rulings regarding Plaintiff's motion *in limine* No. 8 and Defendants' motion *in limine* No. 16.

By granting Plaintiff's motion *in limine* No. 8, the Magistrate Judge excluded reference to the prosecution history, "since disclaimer and estoppel are not jury issues." (Order, at 4.) However, Defendants had intended to use the prosecution histories to show the jury TWW's admissions related to many issues. *See FED. R. EVID. 801(d)(2)(A), (D); i4i Ltd. P'ship v. Microsoft Corp.*, 670 F. Supp. 2d 568, 587 (E.D. Tex. 2009), *aff'd as modified*, 589 F.3d 1246 (Fed. Cir. 2009), *opinion withdrawn & superseded on reh'g*, 598 F.3d 831 (Fed. Cir. 2010), 564 U.S. 91 (2011) (discussing prosecution history of patent); *Mintz v. Dietz & Watson, Inc.*, 679 F.3d 1372, 1381-82 (Fed. Cir. 2012) ("Mintz's argument [during prosecution] for why [a prior art reference] lacks the 'intersecting in locking engagement' claim limitation applies similarly to explain why [defendant]'s accused products also lack that claim limitation."); *Cook Grp. Inc. v. Boston Sci. Scimed, Inc.*, 809 F. App'x 990, 1000 (Fed. Cir. Apr. 30, 2020) ("It is well established, however, that a statement made by a party in an individual or representative capacity may be offered as evidence against that party."); *cf. Commonwealth Sci. & Indus. Rsch. Organisation v. Mediatek Inc.*, No. 6:12-CV-578, 2015 WL 12806515, at *3 (E.D. Tex. June 29, 2015) ("Defendants' experts may use statements from the prosecution history to support their contention that the accused structure is not equivalent.").

For example, Defendants had intended to use the prosecution histories to show the jury TWW's admissions regarding the application of the claims (using the same constructions adopted by the Court) to prior art. *See, e.g., Nat'l Steel Car, Ltd. v. Canadian Pac. Ry., Ltd.*, 357 F.3d 1319,

1334 (Fed. Cir. 2004) (noting that it is “elementary in patent law” that an invalidity assessment is a two-step process, including (1) construing the claims, and (2) applying that construction to the prior art) (citation omitted). Defendants also intended to use the prosecution histories to show the jury TWW’s admissions regarding facts relevant to the nexus inquiry for secondary considerations. The prosecution history may, likewise, help the jury weigh a testifying expert’s opinion about how a person of ordinary skill in the art would have understood the claimed inventions and whether two references would have been obvious to combine. *See, e.g., McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1352 (Fed. Cir. 2001) (discussing trial evidence of examiner’s consideration of references). Respectfully, if Defendants are precluded from relying on this evidence, either in its affirmative case or in cross-examining TWW’s experts, TWW would have the ability to take factual positions before the jury that are inconsistent with factual positions it took during prosecution, simply because the patentee made an inconsistent statement inside the file history instead of outside of it. Allowing the jury to consider and weigh evidence of such inconsistencies prevents this injustice; therefore, Defendants object to the Magistrate Judge’s ruling regarding Plaintiff’s motion *in limine* No. 8.

Conversely, by denying Defendants’ motion *in limine* No. 16, the Magistrate Judge is allowing TWW to argue claim construction to the jury—specifically, that the asserted claims are limited to “airbeds” instead of “inflatable products.” (Order, at 9.) This is highly prejudicial to Defendants. Indeed, “it is improper to argue claim construction to the jury because the ‘risk of confusing the jury is high[.]’” *Cordis Corp v. Boston Scientific Corp.*, 561 F.3d 1319, 1337 (Fed. Cir. 2009) (citation omitted). Therefore, Defendants object to the Magistrate Judge’s ruling regarding Defendants’ motion *in limine* No. 16.

Dated: May 18, 2021

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing document was filed electronically in compliance with Local Rule CV-5(a). Therefore, this document was served on counsel of record, all of whom have consented to electronic service, on this 18th Day of May, 2021.

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